

## REMARKS

By this amendment, Applicants have amended claims 12, 17, 19, 20, 24, 27-29, and 31. As a result, claims 12-33 are pending in this application. These amendments are being made to facilitate early allowance of the presently claimed subject matter. Applicants do not acquiesce in the correctness of the rejections and reserve the right to pursue the full scope of the subject matter of the original claims, or claims that are potentially broader in scope, in the current and/or a related patent application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, the Office objects to the specification as allegedly failing to provide proper antecedent basis for the phrase "computer useable medium". By this response, Applicants have amended claims 29 and 31 to recite "computer recordable medium" as suggested by the Office. As a result, Applicants respectfully request withdrawal of this objection.

Further, the Office rejects claim 28 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In particular, the Office alleges that a graphical user interfaces is not statutory. By this response, Applicants have amended claim 28 to recite a method of generating a graphical user interface as suggested by the Office. As a result, Applicants respectfully request withdrawal of the rejection of claim 28 as allegedly being directed to non-statutory subject matter.

Further, the Office rejects claim 28 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,134,568 (Tonkin). In order to maintain a proper rejection under 35 U.S.C. § 102, the Office must show that a single reference discloses each feature of the claimed invention. In particular, the Office must show that "[t]he

identical invention... [is] shown in as complete detail as is contained in the... claim" to maintain a rejection under 35 U.S.C. § 102. See, e.g., MPEP § 2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). To this extent, as recently reiterated by the Federal Circuit, in order to anticipate the claimed invention, the reference must "disclose[] within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim." *Net Money!N, Inc. v. VeriSign, Inc.*, No. 2007-1565, pp. 17-18 (Fed. Cir. 2008). Applicants respectfully submit that the Office fails to present such a showing.

In support of the rejection, the Office cites: col. 7, lines 11-46 of Tonkin, which discusses a main document editing window shown in FIG. 5B of Tonkin; and col. 12, line 23-col. 13, line 51 of Tonkin, which discusses a viewing window shown in FIGS. 8A-E, and a window for displaying document data shown in FIG. 9 of Tonkin. To this extent, Tonkin discloses the use of three distinct windows. In contrast, the invention of claim 28 generates content for a display area of a graphical user interface that includes a preview area, a navigation area, an estimate area, and a configuration area. Applicants respectfully submit that the Office's citation of the three distinct windows shown and described in Tonkin fails to present a *prima facie* showing that Tonkin discloses not only all of the limitations claimed, but also all of the limitations arranged or combined in the same way as recited in claim 28. As a result, Applicants respectfully request withdrawal of the rejection of claim 28 as allegedly being anticipated by Tonkin.

Further, the Office rejects claims 17, 19, and 31 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,615,234 (Adamske).

With respect to claim 17, Applicants respectfully submit that Adamske fails, *inter alia*, to teach or suggest providing system software for use on a client, which is configured to enable a user of a local application executing on the client to request generation of a print file based on the document using the local application, and generate the print file in response to the request without further user interaction, obtaining document information for the document on the server from the system software executing on the client, generating a unique identifier for the document on the server and transmitting the unique identifier for use by the system software, and obtaining a print file on the server from the system software executing on the client subsequent to obtaining the document information as claimed therein.

Interpreting Adamske only for the purposes of this response, Adamske generally discusses two embodiments for a system and method for delivering an electronic document over a network.

In the first embodiment, discussed from column 4, line 61 through column 6, line 23 of Adamske, a user uploads an electronic document from a client computer to a web server using a web browser or email. Adamske, col. 5, lines 15-16. The electronic document is then converted to a portable printable format on an application translation server. Adamske, col. 5, lines 18-19. In order to perform the conversion, “the application translation program [on the application translation server] houses the variety of client applications that users use to create electronic documents.” Adamske, col. 5, lines 19-21. The converted printable electronic document is then transmitted to a web server, where it is processed to create web-viewable print preview files. Adamske, col.

5, line 64-col. 6, line 3. The user can use the client-side web browser to preview the document. Adamske, col. 6, lines 12-15.

In the second embodiment, discussed from column 6, lines 24-57 of Adamske, "the client computer includes a print driver program... that is executable to convert the electronic document and provide the print preview capability prior to uploading to the web server." Adamske, col. 6, lines 34-38. In particular, the print driver program creates a metafile from the electronic document, which provides a viewable representation of how the document will look upon printing. Adamske, col. 6, lines 46-49. Subsequently, the user "sends this metafile to [the application] translation server through web server and the conversion into a printable (e.g., PostScript) version is performed as previously described." Adamske, col. 6, lines 49-52.

To this extent, contrary to both embodiments of Adamske, in which a printable version of a file is generated on an application translation server, a print file is obtained from system software executing on a client in claim 17. Further, the invention provides system software configured to generate the print file in response to a request generated by a user using a local application executing on the client without further user interaction. In contrast, in Adamske, the print driver program first performs the print preview, and the user must subsequently send a metafile to the application translation server for conversion to the printable version.

In light of the above, Applicants respectfully request withdrawal of the rejections of claim 17 and claim 19, which depends therefrom, as allegedly being unpatentable over Adamske.

With respect to claim 31, Applicants respectfully submit that Adamske fails, *inter alia*, to teach or suggest program code for providing system software for use on a client, wherein the system software allows a user of the client to use a local application to request to remotely print the document, wherein the local application is configured to at least one of: display or edit the document, and wherein, in response to the request and without further user interaction, the system software: generates a print file on the client based on the document, transmits the print file to a server in response to the generation of the print file, and prompts the user to preview a bound copy of the document using a browser in response to the transmission of the print file as claimed therein.

As discussed above, Adamske either teaches the use of no system software on a client to enable a user to request to remotely print a document (first embodiment), or teaches the use of system software that first performs the print preview and subsequently requires the user to send a metafile to the application translation server for conversion to the printable version.

In light of the above, Applicants respectfully request withdrawal of the rejection of claim 31 as allegedly being unpatentable over Adamske.

Further, the Office rejects claims 12-16, 18, 20-27, 29, 30, 32, and 33 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claim 12, Applicants respectfully submit that neither Adamske, Tonkin, nor the proposed combination thereof teaches or suggests, *inter alia*, providing system software for use on a client that allows a user of the client to use a local application to request to remotely print the document, wherein, in response to the request and without further user interaction, the system software: generates a print file

on the client based on the document, transmits the print file to a server in response to the generation of the print file, and prompts the user to preview a bound copy of the document using a browser in response to the transmission of the print file as claimed therein.

Interpreting Tonkin only for the purposes of this response, Tonkin provides a web page in which a user enters a source file that includes the content to be included in a document. Tonkin, FIG. 5B; col. 7, lines 13-17. The source file can be a PDF file or another format, which can be first converted to PDF format. Tonkin, col. 7, line 17-27. Subsequently, image(s) of the document are generated and displayed. Tonkin, col. 12, lines 23-34.

Contrary to both embodiments of Adamske and the teachings of Tonkin, Applicants' system software of claim 12 generates a print file, transmits the print file to a server, and prompts a user to preview a bound copy of the document using a browser in response to a request to remotely print the document received from a local application. In the first embodiment of Adamske and Tonkin, the user is required to request that the document be transmitted using a web browser or by sending an email. In the second embodiment of Adamske, the preview is performed before any communications with a server occur and before a printable version of the document is generated.

To this extent, prior to being prompted to preview a bound copy of a document using a web browser, a print file is generated and transmitted to a server in claim 12. In contrast, in Adamske, the preview will have already occurred (second embodiment) or the user will have opened a web browser intending to preview the document (first embodiment) prior to the print file being generated or transmitted to a server. Similarly,

in Tonkin, the user must first open a web browser intending to preview the document in order to transmit the print file to a server.

As a result, neither Adamske, Tonkin, nor the Office's proposed combination thereof, teaches or suggests providing the system software of claim 12. In light of the above, Applicants respectfully request withdrawal of the rejections of claim 12 and claims 13-16 and 32-33 as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claim 18, Applicants note that the Office relies on its interpretation of Adamske as allegedly teaching all the features of claim 17, from which this claim depends. To this extent, Applicants incorporate the arguments presented above with respect to claim 17. Further, Applicants submit that the proposed combination of Adamske with Tonkin fails to address the deficiencies of Adamske discussed above with respect to claim 17. As a result, Applicants respectfully request withdrawal of the rejection of claim 18 as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claim 20, for reasons that should be obvious in view of the discussion of Adamske and Tonkin above, Applicants respectfully submit that the proposed combination of Adamske and Tonkin fails to teach or suggest the system software claimed therein. As a result, Applicants respectfully request withdrawal of the rejections of claims 20 and claims 21-23, which depend therefrom, as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claim 24, for reasons that should be obvious in view of the discussion of Adamske and Tonkin above, Applicants respectfully submit that the

proposed combination of Adamske and Tonkin fails to teach or suggest the means for providing system software claimed therein. As a result, Applicants respectfully request withdrawal of the rejections of claims 24 and claims 25-27, which depend therefrom, as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claim 29, for reasons that should be obvious in view of the discussion of Adamske and Tonkin above, Applicants respectfully submit that the proposed combination of Adamske and Tonkin fails to teach or suggest the program code for generating a print file on a client based on the document in response to a request received from a local application executing on the client and program code for communicating the print file to a server in response to the generation of the print file without further user interaction as claimed therein. As a result, Applicants respectfully request withdrawal of the rejections of claims 29 and claim 30, which depends therefrom, as allegedly being unpatentable over Adamske in view of Tonkin.

Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary and/or in a related patent application, either of which may seek to obtain protection for claims of a potentially broader scope.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

/John LaBatt/

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